REMARKS

In item one of the office action, it was stated that the first sentence of the specification should be amended to cross reference all other reissue applications. This has been done.

In item two of the office action, it was stated that a statement regarding surrender should be made.

Applicants, by its undersigned attorney, states that it has surrendered the original U.S. Patent No. 5,656,186 upon which this reissue application is based, in the earlier reissue application No. 09/366,685.

In item number three of the office action, it was stated that a supplemental reissue oath or declaration must be received in order to obtain allowance. Applicants respectfully defer submission of the supplemental reissue oath/declaration, and same will be submitted at a later date.

In item four of the office action, it was stated that claim 50 is rejected on the basis that "There is no disclosure in the original specification of a material that is both transparent (as disclosed in claim 50) and organic (as recited in independent claim 46)."

Examiner's attention is respectfully directed to example three of the application which describes experiments performed according to the method of the invention for laser induced breakdown of cornea which is a material that is both transparent and organic.

Further, it should be noted that applicants' claims as submitted in the original parent reissue filing encompassed the application of the method to all materials.

This was supported by testing performed on numerous different materials as set forth in the specification. Applicants characterized the materials broadly to cover all materials, including, but not limited to, opaque, transparent and tissue.

It is well established that the patent owner may assert claims which go beyond the specific embodiment shown in the application. See Ethicon Endosurgery, Inc. v. United States Surgical Corp., 93 F.3d 1572, 40 US PQ2d 1019 (Fed. Cir. 1996).

As in Ethicon, the applicants did not consider the particular material to which the inventive method applied to be part of the invention. Thus, the claims excluded a limitation to the specific material, and the claims as originally issued, were directed to **all materials**. Further, the specific material to which applicants' inventive method applies is not considered part of the invention.

Based on the above, applicants request this rejection be reconsidered and withdrawn.

REJECTION UNDER 35 U.S.C. § 102(e)

Claims 46, 55, 58, 59 and 61 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kautek et al. in the article "Femtosecond pulse laser ablation of metallic, semiconducting, ceramic and biological materials". It was stated in the office action that Kautek has a publication date of April 5, 1994, three days before the filing date of the original application, April 8, 1994. It is assumed that the rejection was meant to be under 102(a) and is being addressed accordingly.

Applicants submit attached hereto, a copy of the web page entry from the sponsoring organization of the aforesaid conference indicating that the proceedings of

such conference were published September 1994. Therefore, it is respectfully submitted that the publication in September 1994 of proceedings which occurred in Europe in April 1994, constitutes a publication only as of the publication date in September. It is well established that circulation or permanency is required if a work is to constitute a printed publication. A paper which is orally presented but where written copies are not disseminated, does not constitute either circulation or permanency. See Massachusetts Institute of Technology v A.B. Fortia, 774 F.2d 1104, 227 U.S.P.Q. 428 (Fed. Cir. 1985).

Nevertheless, in order to facilitate prosecution and issuance of allowable subject matter, applicants herewith submit a declaration under 37 C.F.R. 1.131 demonstrating conception of the invention prior to the earliest possible effective date of the Kautek reference coupled with diligence to the filing date of April 8, 1994. The attached declaration Exhibit 1, parts A, B, and C showing conception of the invention prior to March 31, 1994 and including conception of the determination of damage thresholds for corneal tissue over a range of pulse durations from 150 femtoseconds to 7 nanoseconds and more specifically showing breakdown threshold for ultrashort pulses of less than 10 picoseconds, where the breakdown threshold for ultrashort pulses less than 10 picoseconds are less than the longer pulses and have smaller standard deviations resulting in reduced collateral damage.

Kautek is said to disclose using pulses of 300 femtoseconds for laser ablation of biologic materials in disclosing a pulse width shorter than 10 picoseconds. As shown in Exhibit 1, for such biologic materials, applicants already had possession of at least as much as is allegedly shown by Kautek, before the earliest possible effective

date of Kautek. Therefore, it is respectfully submitted that Kautek does not qualify as a reference due to its publication date being several months after the filing date of the present invention and further because the invention claimed herein was conceived before the earliest possible effective date of Kautek and such conception was coupled with diligence to the subsequent filing of the application (constructive reduction to practice).

REJECTIONS UNDER 35 U.S.C. § 102(e)

Claims 46, 55, 56, 58, 59 and 61 were rejected under 35 U.S.C. 102(e) as being anticipated by Lai ('916).

In response Applicants have amended claims 46, 55, and 61 to include the limitation of having a fluence "greater than 5 J/cm^2". Basis for this limitation exists in the specification at column 8, lines 7-36, and as shown in FIGURES 9 and 10. No new matter has been entered.

The Recited Reference Does Not Teach All Claimed Limitations

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 US.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. §

2131, citing Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully assert that the rejection does not satisfy these requirements.

Claim 46, as amended, at least defines "generating at least one laser pulse which has a pulse width equal to or less than said characteristic laser pulse width and a fluence greater than 5 J/cm^2".

Claim 55, as amended, at least defines "generating at least one laser pulse which has a pulse width equal to or less than said characteristic laser pulse width, said characteristic pulse width being defined by the log ablation threshold of the material as a function of log pulse width position where the ablation threshold function is no longer proportional to the square root of pulse width, and has a fluence greater than 5 J/cm^2".

Claim 61, as amended, at least defines "generating a pulsed laser beam including at least one laser pulse having a pulse width equal to or less than a characteristic pulse width, the characteristic pulse width defined by a region of a log-log relationship between breakdown fluence threshold versus laser pulse width, for said organic material, which exhibits a departure from a square root dependence, and having a fluence greater than 5 J/cm^2".

Lai does not disclose these limitations. As discussed in the specification, at column 3, lines 11-12, Lai teaches an energy density threshold of about 0.2 to 5 : $J/(10:m)^2$. This equates to a range of about 0.2 to 5 J/cm^2. Similarly, Lai discloses having the beam have an ablation energy density of less than or equal to about 5 :$J/(10:m)^2$. This equates to 5 J/cm^2. Since the claims define a fluence greater than 5 J/cm^2, Lai does not teach all of the claimed limitations. Therefore, the Applicants respectfully

assert that for the above reasons claim 46, 55, and 61 are patentable over the 35 U.S.C. § 102 rejection of record.

Claims 56, 58, and 59 depend directly from base claim 55, and thus inherit all limitations of claim 55. Each of claims 56, 58, and 59 sets forth features and limitations not recited by Lai. Thus, the Applicants respectfully assert that for the above reasons claims 56, 58, and 59 are patentable over the 35 U.S.C. § 102 rejection of record.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 47, 51, 54, and 60 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lai ('916) in view of Lin ('679).

In response Applicants have amended claims 54 and 60 to include the limitation of having a fluence "greater than 5 J/cm^2". Basis for this limitation exists in the specification at column 8, lines 7-36, and as shown in FIGURES 9 and 10. No new matter has been entered.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the first and second criteria, Applicants assert that the rejection does not satisfy the third criteria.

The Combination of References Do Not Teach All of the Claim Limitations

The Office Action admits that Lai does not teach a laser having laser pulse energy in the range recited by the claims. The Office Action attempts to cure this deficiency by introducing Lin, which the Office Action alleges to teach having such a laser pulse energy. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 46, as amended, at least defines "generating at least one laser pulse which has a pulse width equal to or less than said characteristic laser pulse width and a fluence greater than 5 J/cm^2".

Claim 54, as amended, at least defines "generating a pulsed laser beam including at least one laser pulse which has a pulse width equal to or less than said predetermined laser pulse width, and has a fluence greater than 5 J/cm^2".

Claim 60, as amended, at least defines "generating at least one laser pulse which has a width equal to or less than said characteristic laser pulse width where the laser pulse width is in a range of from about 10 to about 10,000 femtoseconds, the pulse has an energy of from about 10 nanojoules to about 1 millijoule, and the pulse has a fluence greater than 5 J/cm^2".

Lai does not disclose these limitations. As discussed in the specification, at column 3, lines 11-12, Lai teaches an energy density threshold of about 0.2 to 5 : J/(10:m)^2. This equates to a range of about 0.2 to 5 J/cm^2. Similarly, Lai discloses having the beam have an ablation energy density of less than or equal to about 5 :J/(10: m)^2. This equates to 5 J/cm^2. Since the claims define a fluence greater than 5 J/cm^2, Lai does not teach all of the claimed limitations. Lin is not relied upon in the Office

Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention. Thus, the Applicants respectfully assert that for the above reasons claims 54 and 60 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 47 and 51 depend directly from base claim 46, and thus inherit all limitations of claim 46. Each of claim 47 and 51 sets forth features and limitations not recited by the combination of Lai and Lin. Thus, the Applicants respectfully assert that for the above reasons claims 47 and 51 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claims 48 and 49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Lai ('916) in view of Nishiwaki et al. (Japanese Patent 62-93,095, hereinafter Nishiwaki).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the first and second criteria, Applicants assert that the rejection does not satisfy the third criteria.

The Combination of References Do Not Teach All of the Claim Limitations

The Office Action admits that Lai does not teach using different f numbers to change the spot size. The Office Action attempts to cure this deficiency by

introducing Nishiwaki, which the Office Action alleges to provide such a teaching. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 46, as amended, at least defines "generating at least one laser pulse which has a pulse width equal to or less than said characteristic laser pulse width and a fluence greater than 5 J/cm^{2}".

Lai does not disclose these limitations. As discussed in the specification, at column 3, lines 11-12, Lai teaches an energy density threshold of about 0.2 to 5 : J/(10:m)^{2}. This equates to a range of about 0.2 to 5 J/cm^{2}. Similarly, Lai discloses having the beam have an ablation energy density of less than or equal to about 5 :J/(10: m)^{2}. This equates to 5 J/cm^{2}. Since the claims define a fluence greater than 5 J/cm^{2}, Lai does not teach all of the claimed limitations. Nishiwaki is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention.

Claims 48 and 49 depend directly from base claim 46, and thus inherit all limitations of claim 46. Each of claim 48 and 49 sets forth features and limitations not recited by the combination of Lai and Nishiwaki. Thus, the Applicants respectfully assert that for the above reasons claims 487 and 49 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Claim 52 is rejected under 35 U.S.C. §103(a) as being unpatentable over Lai ('916) in view of Nishikawa et al. (Japanese Patent 62-144,893, hereinafter Nishikawa).

In response Applicants have amended claim 52 to include the limitation of having a fluence "greater than 5 J/cm^2". Basis for this limitation exists in the specification at column 8, lines 7-36, and as shown in FIGURES 9 and 10. No new matter has been entered.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding the first and second criteria, Applicants assert that the rejection does not satisfy the third criteria.

The Combination of References Do Not Teach All of the Claim Limitations

The Office Action admits that Lai does not teach using different f numbers to change the spot size. The Office Action attempts to cure this deficiency by introducing Nishiwaki, which the Office Action alleges to provide such a teaching. However, this combination, as presented, does not teach or suggest all limitations of the claimed invention.

Claim 52, as amended, at least defines "generating a laser beam including at least one laser pulse which has a pulse width equal to or less than said predetermined laser pulse width, and has a fluence greater than 5 J/cm^2".

Lai does not disclose these limitations. As discussed in the specification, at column 3, lines 11-12, Lai teaches an energy density threshold of about 0.2 to 5 :

$J/(10:m)^2$. This equates to a range of about 0.2 to 5 J/cm^2. Similarly, Lai discloses having the beam have an ablation energy density of less than or equal to about 5 :$J/(10:m)^2$. This equates to 5 J/cm^2. Since the claims define a fluence greater than 5 J/cm^2, Lai does not teach all of the claimed limitations. Nishikawa is not relied upon in the Office Action as disclosing these limitations. Therefore, the combination of references does not teach all elements of the claimed invention. Thus, the Applicants respectfully assert that for the above reasons claim 52 is patentable over the 35 U.S.C. § 103(a) rejection of record.

REJECTION BASED ON ALLEGED RECAPTURE

In item 13 of the office action, claims 46-51 and 55-59 were rejected under 35 U.S.C. § 251 as being an improper recapture on the basis that in the prosecution of the parent, 5,656,186 (USSN 08/224,961), in reply to the rejection of August 10, 1995, the amendment of December 4, 1995 argued that Miyauchi does not employ pulse widths that are less than the characteristic pulse width and speculates that since the preamble of aforesaid claim 1 in the parent case recited "the material being characterized by a relationship of fluence breakdown threshold versus laser pulse width having a rapid and distinct change in slope" that to not have such limitation as to rapid and distinct would be an improper recapture of subject matter previously surrendered during prosecution.

It should be noted that a similar rejection was made in the reissue application, and such rejection was withdrawn. Such withdrawal was at least on the basis that original claim 36 described the change in slope as being merely distinct.

It is respectfully submitted that examiner has taken a single isolated statement from the remarks submitted in December of 1995 to attempt to provide a foundation for limiting the characterization of the slope to be rapid and distinct. However, a full and complete reading of the response submitted in December 1995 demonstrates that the important characteristic being identified was the break point in the slope of the laser induced breakdown threshold. The relevant portions of the remarks of December 1995 in parent USSN 09/224,961 are included herewith, taken from pages 9-11 thereof.

> Although not expressly so stated, the rejection on the basis of Miyauchi may be based on alleged inherency. A review of Miyauchi does not reveal a teaching of the key feature of the present invention whereby "a relationship of fluence breakdown threshold versus laser pulse width exhibits a rapid and distinct change in slope at a predetermined or characteristic pulse width". It is axiomatic that, in order to "anticipate" a claim, "all the elements in the claim (or possibly their equivalents . . .) must have been disclosed in a single prior art reference or device." Radio Steel & Mft. Co. v. MTD Products, Inc., 731 F.2d 840, 845, 221 USPQ 657, 661 (Fed. Cir. 1984). Moreover, "it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 USPQ2d 1461, 1462 (BPAI 1990). It appears that the rejection may be based upon the assumption that the material involved in Miyauchi inherently exhibits such a characteristic and

that the pulse width employed in Miyauchi are inherently less than this pulse width.

First, there is no teaching in Miyauchi of the characteristic in question, therefore, there is nothing "predetermined" or "characteristic" about the critical pulse width. Second, the pulse widths employed in Miyauchi are not in fact less than the critical pulse width. Miyauchi proposes to employ pulse widths in the range of 100-300 picoseconds for lasing metal (Al) (Column 2 at line 58), Miyauchi's pulse widths are considerably greater than the pulse widths required by the method of the present application for metal (Au) about 10 picoseconds or less. (See arrow, Figure 3 of the application). Third Miyauchi states that the peak power required for cutting is inversely proportional to the square root of pulse width. (See Miyauchi at Column 2 at line 30.) Accordingly, Miyauchi shows that the threshold for damage is proportional to the square root of pulse width. This is exactly what the present application demonstrates is not the case.

The present application demonstrates that in a particular operating range, approximately 10 picoseconds or less, there is a breakpoint in the slope of the laser induced breakdown threshold. By the method of the present invention, ablation is accomplished in the range of pulse width less than the breakpoint. In contrast, Miyauchi et al. did not have an understanding of breakdown in this important, critical range. In short, the pulse widths disclosed in Miyauchi are greater than those described by the

present application at the change of slope point. For material of the type described in Miyauchi, the slope change occurs at less than 10 picoseconds whereas Miyauchi operates in the range of 100-300 picoseconds, completely missing the important feature of the invention. Miyauchi adheres to the old thinking that the scaling law should be followed through the operating range. Therefore, based on Miyauchi one would not be able to project that an optimal range pulse width is identifiable as in the present invention. Therefore, the old thinking exemplified by Miyauchi et al. is surprisingly disproved by the present invention.

In summary, Miyauchi does not employ pulse widths that are inherently less than the "predetermined pulse width" as defined in the preamble of claim 1 as filed. Miyauchi does not employ pulse widths that are inherently less than the "characteristic pulse width" as defined in claim 1 as now amended. In that regard, it appears that the Office Action analysis overlooks the preamble which gives meaning to the claim and is essential to a key feature of the invention. Such a preamble cannot be overlooked, especially when step 9a) of claim 1 as filed referred to "said predetermined pulse width"; and claim 1 as amended refers to "said characteristic pulse width". In determining anticipation, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. (See Porter v. Farmers Supply Service, Inc., 790 F.2d 882, 229 U.S.P.Q. 814, 816 (Fed. Cir. 1986); and

Pac-Tec, Inc. v. Amerace Corp., 903 F/2d 796, 14 U.S.P.Q.2d 1871 (Fed. Cir. 1990). Therefore, Miyauchi cannot anticipated the invention of claims 1 through 5, 8 through 17, and 39. New claim 40 is not anticipated by Miyauchi for the same reasons.

In response to the earlier rejection based on Miyauchi, Applicant's argued that there is no teaching of Miyauchi of the characteristic in question since, Miyauchi's pulse widths are considerably greater than the pulse widths required by the method of the present invention. In the present application, in a particular operating range, there is a break point in the slope of the laser induced breakdown threshold. By the method of the present invention, ablation is accomplished in the range of pulse width less than the break point. In contrast, Miyauchi did not have an understanding of the break point. Further, pulse widths disclosed in Miyauchi are greater than those described in the present application at the change of slope point. There is further discussion in the aforesaid response concerning the important feature of the invention being the change in slope point and operating in a range at or below such change in slope point. Further, Miyauchi teaches that the threshold for damage is proportional to the square root of pulse width which is exactly what the present invention demonstrates is not the case.

Therefore, applicants' characterization of the characteristic pulse width rests on the break point in the slope of the curve or a change in the slope of the curve resulting in effectively mitigating thermal affects. Such is further admitted in the later reasons for allowance, which is broader than any of the terms rapid, distinct, and "rapid and distinct". Such reasons for allowance are directed to laser induced breakdown of a material characteristic by a relationship of fluence breakdown threshold using laser

pulse width that exhibits a change in slope "at a predetermined laser pulse width so that ablation is by laser pulses having a width equal to or less than the predetermined pulse width laser, uses a lower pulse energy than that of the prior art in the femtosecond range to ablate without thermal affects to enable more precise machining of the substrate." (Reasons for Allowance in USSN 08/224,961 dated January 21, 1997 at pages 2-3.)

In summary, although the change in slope may be more or less abrupt or rapid, such change in slope is determinable and distinguishable and accordingly, claims as filed included claims of varying scope such as in claim 36 as filed which states that the relationship of fluence breakdown threshold versus laser pulse width exhibits a distinct change in slope at a characteristic laser pulse width. This point is further emphasized in the response amendment filed November 1996. Excerpts of which are given below, taken from pages 16-17.

> In summary, the present invention contradicts Miyauchi and conventional thinking by new data. This new data demonstrates that for a metal, such as Al and Au, LIB mechanism as defined in the items above, and in the present invention, occurs at a laser pulse well outside Miyauchi's 100 to 300 picoseconds. Miyauchi never suggested the femtosecond range of the present invention necessary to achieve LIB mechanism; and Miyauchi never identified the present invention's "change of slope" characterization. (See Declaration at item 15.)
>
> The present invention relies upon the production of a spontaneous plasma formed by LIB to effect the ablation, and recognizes that thermal

effects are virtually eliminated from the process when operating near the threshold. Therefore, the present invention deviates completely from Miyauchi's $1/t^{1/2}$ behavior. The novel plasma process occurs when one operates below the critical point defined by the present invention's "distinct change of slope" in the damage fluence versus pulse width threshold curve. The present invention, for the first time, specifically teaches that one should avoid doing what Miyauchi et al teach. That is to say, the present invention avoids thermal based ($1/t^{1/2}$) behavior entirely. In contrast, Miyauchi relies on such thermal ablation process. (See Miyauchi at Col. 2 at lines 30-45.) (See Declaration at item 16.)

As can be seen from the foregoing, the arguments of record distinguish Miyauchi on the basis that Miyauchi teaches utilization of the $1/t^{1/2}$ conventional scaling law feature for ablating material. In contrast, the present invention teaches departure from conventional behavior and operating in the point where such departure occurs. The important feature is the discernable change in slope at the point of departure. Such change in slope is identifiable. Whether such change in slope is relatively abrupt and rapid or not, is not the point.

According to the case law cited by the examiner and applying such case law to the present situation, it can be seen that the term rapid, the term distinct, and the phrase rapid and distinct, were not stated to be limitations necessary to overcome the prior art. To the contrary, the change in slope is what was argued as being distinguishable from the prior art. Therefore, it cannot be said that there was any surrender based on the term rapid, the term distinct, or the phrase rapid and distinct.

As can be seen in the present situation, reissue claims pending here are not broader than the original claims in a manner directly pertinent to a prior art rejection. In fact, claim 36 issued in the parent reissue application with only the term distinct rather than the phrase "rapid and distinct". The present claims are no broader than issued claim 36. Also, arguments were made during the prosecution of the reissue application that relied solely on the distinct change in slope, rather than any "rapid and distinct" change in slope. Subject matter relied upon in this manner cannot be said to have been surrendered.

It bears repeating that the inventive concept here is the relationship of fluence breakdown threshold versus laser pulse width that departs from the scaling law and such departure is determinable as a change in slope. The relative steepness or shallowness of such change in slope is not critical. Accordingly, applicants submit that the examiner has taken the isolated phrase "rapid and distinct" out of the broader context of both the prosecution history of this file and the reasons for allowance; and thus, the rejection is improper.

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Applicants submit herewith a Supplemental Information Disclosure Statement (IDS) identifying three printed publications. Applicants cite one of these publications, Kautek *et al.* entitled "Femtosecond-pulse Laser Ablation Of Human Corneas", out of an abundance of caution even though they do not believe that it, in fact, constitutes prior art. Kautek *et al.* was submitted and accepted for publication before the filing date of the present application (June 25, 1993 and September 28,

1993, respectively) but was not published until May 1994, which is after the filing date of the present application in April 1994.

Under the controlling law, a technical paper is considered a "printed publication" when it has been made available to the extent that skilled practitioners in the subject art can locate it and comprehend therefrom the essentials of the claimed invention. *See*, Manual of Patent Examining Procedures, § 2128; *Massachusetts Institute of Technology v. AB Fortina*, 227 USPQ 428, 432 (Fed. Cir. 1985) citing *In re Wyer,* 210 USPQ 790, 794 (C.C.P.A. 1981). In the present instance, Kautek *et al.* would be considered a "printed publication" as of its publication date – May, 1994. *See, In re Bayer,* 196 USPQ 670, 673 (C.C.P.A. 1974); *National Semiconductor Corp. v. Linear Technology Corp.,* 8 USPQ2D 1359, 1362 (N.D. Cal. 1988) (papers submitted to a technical subcommittee to be evaluated for possible publication is not considered prior art as a printed publication); *Xerox Corp. v. 2Com Corp.,* 49 USPQ2d 1772, 1775-776 (W.D.N.Y. 1998) (submission of a paper for review by a scientific committee prior to publication does not constitute prior art as a "printed publication").

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: November 15 2002

By: _____

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